

REMARKS:

Claims 1, 4-11, 14-21, and 24-29 remain in the application for consideration of the Examiner.

Claims 1, 4-11, 14-21, and 24-29 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,675,354 to Claussen et al. in view of U.S. Patent No. 6,535,896 to Britton et al.

Reconsideration and withdrawal of the outstanding rejections is respectfully requested in light of the following remarks.

REJECTIONS UNDER 35 U.S.C. § 103(a):

Claims 1, 4-11, 14-21, and 24-29 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,675,354 to Claussen et al. ("Claussen") in view of U.S. Patent No. 6,535,896 to Britton et al. ("Britton").

This rejection is respectfully traversed. Applicants maintain that the present claims cannot be rendered obvious by the proposed combination of Claussen and Britton for at least the reasons stated in the Response Pursuant to 37 C.F.R. § 1.111 filed on 24 June 2004 ("previous Response").

For example, with respect to claim 1, this claim recites in part:

a web page processing engine operable to ... transform the standard content generation tags into first output that the web browser is able to interpret, the web page processing engine unable to interpret the custom content generation tags;

the web page processing engine further operable to communicate the first output and the custom content generation tags to the web server;

In the previous Response, it was pointed out that Claussen and Britton both fail to disclose, teach, or suggest a web page processing engine that is able to transform standard content generation tags, but unable to interpret custom content generation tags. The Office Action concedes that Claussen fails to disclose or suggest these limitations.

With respect to Britton, this reference does not even disclose the use of custom content generation tags. Similarly, Britton does not disclose communicating the first output (the transformed standard content generation tags) along with the custom content generation tags back to the web server since it does not disclose the concept of custom content generation tags.

The Office Action addresses this argument by stating that “[i]n response to applicant’s argument, examiner asserts that since applicant’s amendment by amending claims and deleting limitations in the claims, hence it is necessitated the new ground(s) of rejection presented in this Office Action.”¹ This statement is interpreted to mean that the present Office Action presents new grounds for rejecting these limitations. However, no such new ground seems to be present in the Office Action. The Office Action still concedes that Claussen does not disclose these limitations, and the Office Action still cites only Britton as allegedly disclosing these limitations (which is traversed above). Clarification is therefore respectfully requested.

In addition, the following two arguments were presented in the previous response, but the present Office Action fails to address them.

In the previous response, it was pointed out that claims 5, 15, and 24 are further considered allowable because Claussen and Britton fail to disclose, teach, or suggest that “the custom content generation tags comprise JSP custom tags” and that “the web page processing engine comprises a JSP engine unable to process the JSP custom tags.” First, contrary to the Examiner’s arguments, Claussen does not disclose JSP custom tags. Instead, Claussen refers to XML custom tags. In fact, Claussen teaches that JSP does not have custom tags.² As described in the present Application, JSP 1.0 does not provide for custom tags, while JSP 1.1 does.³ Therefore, Claussen’s references to JSP not having custom tags may be referring to JSP 1.0. Furthermore, contrary to the Examiner’s arguments, Britton does not disclose a web page processing engine comprising a JSP engine that is unable to process the JSP custom tags. Britton does not even mention JSP,

¹ Office Action, page 4, lines 6-8 (sic throughout).

² See Claussen, col. 2, lines 35-38 and col. 7, lines 36-45.

³ See Application, Page 4, line 14 - Page 5, line 11.

so it certainly does not disclose a JSP engine unable to process the JSP custom tags. Therefore, for at least this additional reason, Applicant maintains that claims 5, 15 and 24 are in condition for allowance.

Also in the previous Response, it was pointed out that claims 7 and 17 are further considered allowable because Claussen and Britton fail to disclose, teach, or suggest that “the web page processing engine is operable to attach a header to the custom content generation tags, the header indicating the presence of the custom content generation tags” and that “the web server is operable to communicate the custom content generation tags to the transformation engine in response to the header.” The Examiner states that Britton discloses these limitations (Applicant assumes that the Examiner is referring to the disclosure in Britton of “masking” certain portions of a web page). However, Britton does not disclose attaching a header to a custom content generation tag (since it doesn’t disclose such tags) and it also does not disclose that such a header indicates the presence of a custom content generation tag (since Britton only discloses masking portions of code, not that any specific type of code is identified). Furthermore, the masking disclosed in Britton certainly does not cause a web server to communicate the masked content based on the “masking”, unlike the headers recited in claims 7 and 17. Therefore, for at least this additional reason, Applicant maintains that claims 7 and 17 are in condition for allowance.

Independent claims 11, 21, and 29 recite limitations similar to those discussed above in connection with claim 1. Accordingly, claims 11, 21, and 29, as well as their dependent claims, cannot be rendered obvious by the proposed combination of Claussen and Britton for at least the same reasons discussed above in connection with claim 1.

Accordingly, for at least the reasons discussed above, claims 1, 4-11, 14-21, and 24-29 cannot be rendered obvious by the proposed combination of Claussen and Britton. Therefore, it is respectfully requested that the rejection of claims 1, 4-11, 14-21, and 24-29 be reconsidered and withdrawn.

The Legal Standard for Obviousness Rejections Under 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:


In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

The undersigned hereby authorizes the Director to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing the Amendment to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

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Date


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